2176

PATENT
Atty. Docket No. 27600/M239A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): James L. Warmus et al.

Serial No.: 09/852,581

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Title: IMPOSITION PROCESS AND APPARATUS FOR VARIABLE IMAGING

Group Art Unit: 2176

Examiner: Stephen S. Hong

Certificate of Mailing

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March 4, 2004

Erin J. Fox
Registration No. 52,261

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The patents, publications and other documents listed on the enclosed PTO Form-1449 are submitted pursuant to 37 CFR §§ 1.56, 1.97, and 1.98. Copies of the documents are enclosed as necessary.

In April of 2003, applicants' assignee, RR Donnelley (hereinafter "RRD") offered to license or sell a portfolio of patents to several companies, including Xerox Corporation of Stamford, Connecticut (hereinafter "Xerox"). The patents in the portfolio included the U. S. Patents cited as A183, A184, A186, A187, A190, A192, A193, A196, A199, A200, and A202 in the accompanying PTO Form 1449. In a letter dated December 2, 2003, Mr. Ronny Fogel, Director of Intellectual Property of Creo IL. Ltd., of Herzlia, Israel (hereinafter "Creo," who purchased Scitex Digital Printing (SDP), believed to be the owner and/or developer of a software product known as "Darwin") responded on behalf of Xerox and stated that: "the

following prior art precludes valid assertion of the pertinent patents against Darwin: Kodak 3500; Kodak's Ektaprint 1392; Scitex Digital Printing's Begin; and The Mail Merger function running under WordPerfect 5.1." (These items of art are hereinafter referred to as the "Creo-cited art") Mr. Fogel's letter of December 2, 2003 did not include any documents or other information describing any of the Creo-cited art. On December 9, 2003, a letter was sent by the law firm of the undersigned requesting any and all documentation Mr. Fogel had in connection with the Creo-cited art. To date, no documents or information have been received from Creo concerning the Creo-cited art.

In an attempt to locate documentation and/or other information relating to the Creo-cited art, applicants' assignee conducted searches that ultimately located the documents identified as A114, A116, A178, A182, A188, and C99-C115 in the accompanying PTO Form 1449. In addition, in December 2003, RRD sought to determine whether any employee of RRD had any knowledge of the Creo-cited art. Upon investigation, it was found that two employees of RRD Direct (a wholly-owned subsidiary of RRD), Messrs. Bijukutty John and Thomas Sagenbrecht, had worked with the Begin software starting in 1994 or 1995. (Mr. John resigned from RRD Direct on or about February 25, 2004). In addition, a former RRD employee, Mr. Paul Kaminskas, was found to have worked with the Begin software at RRD Direct in approximately late 1997 or early 1998 to address a customer's requirements to reduce production cycle time and manage the use of several print providers. None of these gentlemen was an inventor of any of the subject matter claimed in the present application or any of the applications that issued as the patents noted in the attached PTO Form 1449, nor was any an attorney or agent who prepared or prosecuted any such applications, nor were any of these gentlemen substantively involved with the preparation or prosecution of any such applications. A summary of the understandings of Messrs. John, Sagenbrecht, and Kaminskas relative to the Begin software is set forth below.

A portion of the Begin software was initially programmed for an Apple Macintosh as a Quark XPress Xtension, and was later ported over to the Windows operating system. The remainder of the software was run on a Sun workstation, as noted in greater detail below.

The Begin software was purchased and tested by RRD Direct in an attempt to commercially create documents having fixed and variable data thereon. Specifically, the workflow that was envisioned for use with the Begin software began with the creation by a designer of separate fixed and variable image portions (the variable image portion was typically referred to as an "imaging plane." For convenience, the fixed image portion will

hereinafter be referred to as a "fixed plane.") Also, a database was assembled containing the variable data. The fixed plane was used to produce plates for a conventional four-color offset press that produced a printed paper web comprising pages of fixed information. Thereafter, the printed paper web was passed under an SDP 3000 Series inkjet printer separate from the offset press. (The web after printing by the offset press was either immediately sent to the inkjet printer in an on-line process, or was stored and later sent to the inkjet printer in an off-line process.) The inkjet printer included inkjet heads that were controlled in accordance with signals developed by the Sun workstation. Specifically, the Sun workstation merged the data stored in the database with the data defining the imaging plane. The merged data were then sent to a collator/raster image processor unit that, in turn, provided command signals to the heads of the inkjet printer to cause the inkjet printer to print variable information.

According to Messrs. John, Sagenbrecht, and Kaminskas, RRD Direct was unable to get the Begin software to work at commercial speeds, even after repeated testing and after numerous visits by and/or consultations with SDP representatives. This was apparently due to the fact that all of the data of the imaging plane had to be raster image processed (or RIP'd) in preparation for printing of each page. In other words, the entire imaging plane had to be RIP'd for every page printed by the ink jet printer. This limitation resulted in extreme overhead requirements on the collator/raster image processor unit, thereby slowing production speeds unacceptably.

The document C105 identified in the accompanying PTO Form 1449 mentions three basic tasks for the Begin software: "The software sets up the position of the print heads on the web, lays out the pages and merges the variable data." *Scitex Digital Printing looks to Quark Xpress*, THE SEYBOLD REPORT ON PUBLISHING SYSTEMS, July 20, 1994, Volume 23:20, page 34. The document C101 describes:

> two modules: a web layout/page composition module designed to run on a PC under MS DOS®/Windows®; and a data merge module that runs on a Sun® SPARCstation® computer with the UNIX® operating system. The web layout/page composition module operates within QuarkXPress™ for Windows, and gives designers a large array of graphic design tools from which to choose. Proofing stations allow the designer to see exactly what the finished product will look like. Once data merge files have been created in the design process, they are transferred to the data merge module.

Form 20-F, Scitex SEC Report, 1997 (Page 15).

The document C105 further discloses that:

> The page layout may contain fixed as well as variable items. Fixed text boxes can be rotated freely or modified in any other way that Xpress permits. They will be "prerasterized" before printing takes place and transferred to the printer as a bitmap that will be printed on every page.

Scitex Digital Printing looks to Quark Xpress, THE SEYBOLD REPORT ON PUBLISHING SYSTEMS, July 20, 1994, Volume 23:20, page 35.

Also according to these documents, once data merge files have been created in the design process, they are transferred to the data merge module. The number of design stations linked to the data merge process can be expanded. During the merging task, the variable data for each page are composed and written to an output tape that drives the printer.

Applicants, undersigned applicants' attorneys, those substantively associated with the prosecution of the present application, and Messrs. John, Sagenbrecht, and Kaminskas have been unable to find any evidence that the Begin software ever operated in a manner to RIP reusable portions of an imaging plane and reuse the resulting bitmap multiple times to create multiple pages. In fact, as noted above, it is RRD Direct's understanding, as embodied in the recollections of Messrs. John, Sagenbrecht, and Kaminskas, that all portions of the imaging plane (whether reusable or not) had to be re-RIP'd after merging thereof with the data in the database.

According to the recollection of Mr. Kaminskas, and contrary to the quoted language from the document C101 above, there were no offline proofing capabilities available at least in late 1997 or early 1998 directly from the Begin software. Proofs had to be created on the SDP 3000 series printer. At that time, SPD was apparently looking into adding proofing capabilities, possibly through third-party software.

Also in accordance with Mr. Kaminskas' recollection, although customer QuarkXPress™ files could be used with the Begin software, QuarkXPress™ files could not be created from the Begin software. As an example, a customer could provide a QuarkXPress™ file with their layout for the imaging layer which contained QuarkXPress™ features that Begin did not support. These items could be corrected so that they complied with Begin, but the modified layout could not be sent back to the customer as a QuarkXPress™ file for their review unless the same changes were made independently under QuarkXPress™. If there were a number of changes, this could be an error-prone process.

Still further in accordance with Mr. Kaminskas' recollection, the Data Merge task was performed on the Sun Workstation using fonts for the variable fields that were defined by the Begin software. These fonts were resident on the Sun workstation. The fonts used by the fixed fields of the imaging layer were on the computer that ran the Begin software. There could be differences in a font between the UNIX and Macintosh (or Windows) environments. This would be most apparent when a variable field was embedded within a surrounding fixed field using the same font.

Mr. Kaminskas further recalls that reflowing of variable text within fixed text was not undertaken because it was simply too time consuming. This is addressed in document C17, page 35, 2nd paragraph under the "Laying out pages" section.

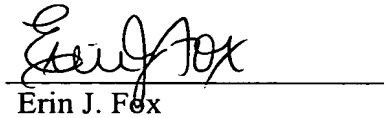
Mr. Kaminskas' recollections as set forth above are not inconsistent with the recollections of Messrs. John and Sagenbrecht.

This information disclosure statement is being filed after the mailing date of a first Office but, to the best of the undersigned's knowledge, before the mailing date of a final action under 37 CFR § 1.113 or notice of allowance under 37 CFR § 1.311. Therefore, in accordance with 37 CFR § 1.97(c), submitted herewith is the fee set forth in 37 CFR § 1.17 (p) for submission of an information disclosure statement under 37 CFR § 1.97(c).

An early and favorable action on the merits is respectfully requested.

Respectfully submitted,

McCracken & Frank LLP
200 W. Adams
Suite 2150
Chicago, Illinois 60606
(312) 263-4700
Customer No.: 29471

By: 
Erin J. Fox
Registration No. 52,261

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